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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,084	05/03/2002	Friedhelm Eisenbeiss	MERCK 2336	6107
23599	7590	01/28/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			NOGUEROLA, ALEXANDER STEPHAN	
		ART UNIT		PAPER NUMBER
				1753

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/018,084	EISENBEISS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ALEX NOGUEROLA	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 November 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 May 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. Applicants' amendment of November 22, 2004 does not render the application allowable.

### *Response to Arguments*

2. Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive. Applicants allege that Quake does not imply three transport electrodes as asserted by the Examiner in the rejection of claim 1 under 35 U.S.C. 102(e), “[r]ather Quake claims a pair of electrodes.” Quake discloses a microfluidic device having a series of branched channels. See Figure 1. Quake also discloses *pulling* molecules through the device “via electrosomotic flow with an electric field set up between the inlet end and the outlet end [emphasis added].” See col. 12:47-50 (both Figure 1 and col. 12:47-50 were cited in the rejection of claim 1). However, since there are two outlets (26,28) and one inlet (24) (see Figure 1) then implicitly there are three electrodes associated with the device: an inlet electrode and two outlet electrodes. This must be so, as electroosmosis is caused by applying an electric field between electrodes at each end of a capillary. See in *A Dictionary of Electrochemistry* under the entry for “Electroosmosis” the first paragraph and Figure E.10”. That is, fluid could not be electroosmotically caused to flow along a capillary branch to an outlet that did not have an electrode. Indeed, Quake

indirectly discloses this through his description of an electrosomotic “switch” for selectively directing fluid to one of two branch channels. See col. 8:46-54.

***Status of Rejections pending since the Office action of May 21, 2004***

3. All previous rejections are withdrawn. Note, though, that the rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) have been restated below in light of Applicants' amendment.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Quake et al. (US 4,221,654 B1), hereafter “Quake.”

Addressing claim 1, Quake teaches an apparatus (20) for discharging fractions for planar microstructured analytical systems (abstract), the apparatus for discharging fractions consisting essentially of a branched channel system (30,40,42), at least three transport electrodes (implied

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by col. 12, ll. 47-54, which teaches creating an electric field for transport between an inlet and an outlet, and Figure 1 and col. 7, ll. 8-10, which teach at least two outlets (26,28)), at least one detection apparatus (36) upstream of a branching point of the channel system and an electrical switching apparatus ((38); also see Figures 4A-C).

Addressing claim 3, Figure 1 shows the apparatus as part of a planar microstructured analytical system.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quake et al. (US 4,221,654 B1), hereafter “Quake,” in view of Slater et al. (WO 95/10040 A1), hereafter “Slater.”

Quake teaches an apparatus for discharging fractions for planar microstructured analytical systems (abstract), the apparatus for discharging fractions consisting essentially of a branched channel system (30,40,42), at least three transport electrodes (implied by col. 12, ll. 47-54, which teaches creating an electric field for transport between an inlet and an outlet, and Figure 1 and col. 7, ll. 8-10, which teach at least two outlets (26,28)), at least one detection apparatus (36) upstream of a branching point of the channel system and an electrical switching apparatus ((38); also see Figures 4A-C).

Although Quake discusses optical detectors, an electrochemical detector is not mentioned. Slater teaches an electrochemical detector for microstructured electrophoresis system (abstract). It would have been obvious to one with ordinary skill in the art at the time the

invention was made to use an electrochemical detector as taught by Slater in the invention of Quake because small organic compounds, such as catecholamines (page 8 of Slater) can be detected without having to tag or label the analyte as in Quake (col. 5, ll. 7-20).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alex Noguerola  
Primary Examiner  
AU 1753  
January 25, 2005